



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

5

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,053	04/06/2000	James W. Williams	29666/35415	1413

7590 03/23/2004

Marshall O'Toole Gerstein  
Murray & Borun  
6300 Sears Tower  
233 South Wacker Drive  
Chicago, IL 60606-6402

EXAMINER
----------

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
----------	--------------

1617

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/529,053

**Applicant(s)**

WILLIAMS ET AL.

**Examiner**

Shengjun Wang

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-25 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 16-25 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1617

### **DETAILED ACTION**

Receipt of applicants' amendments and remarks submitted December 29, 2003 is acknowledged.

#### ***Claim Rejections 35 U.S.C. 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 16, 17, 20, 21, 24, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weithmann et al. (US Patent 5,556,870) for reasons set forth in the prior office action.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weithmann et al. (US Patent 5,556,870) in view of Flamand et al. for reasons set forth in the prior office action.

3. Claims 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weithmann et al. (US Patent 5,556,870) in view of Hammer (AIDS 1996, vol. 10, suppl 3, s1-s11) for reasons set forth in the prior office action.

Claims 16-20, 21, 24, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coghlan et al. (WO 94/24095) in view of McChesney et al. (Transplantation, Vol. 57, no. 12, page 1717-1722) for reasons set forth in the prior office action.

Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coghlan et al. (WO 94/24095) in view of McChesney et al. (Transplantation, Vol. 57, No. 12,

Art Unit: 1617

page 1717-1722), and further in view of Hammer (AIDS 1996, vol. 10, suppl 3, s1-s11) for reasons set forth in the prior office action.

### ***Response to the Arguments***

Applicants' amendments remarks and declaration submitted December 29, 2003 have been fully considered, but are not persuasive for reasons discussed below.

4. With respect to the declaration by Edward s. Mocarski under 37 CFR 1.132 filed June 26, 2003, note the examiner did not simply ignore the declaration. The evidence of nonobviousness provided in the declaration is not sufficient to outweigh the obviousness evidence provided by the prior art. Applicants' opinion and comments about Weithmann's mechanistic interpretation can not negate the fact that Weithmann teaches to use leflunomide for treating viral infection (see the claim). As discussed in prior office action, the functional limitation "for inhibiting viral replication in cells," does not carry patentable weight since it does not distinct the method herein claimed from the method suggested by prior art.

Applicants contend that Coghaln did not provide sufficient evidence (scientific publication) to support his claims for treating viral infection, and Coghaln did not teach expressly to employ open-ring leflunomide compound for treating viral infection. These arguments are not persuasive. First, Coghaln teach the general structures which would encompass the open-ring leflunomide, see, particularly the abstract. Note the question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must considered. In re Lamberti and Konort (CCPA), 192 USPQ 278. Further, one

Art Unit: 1617

of ordinary skill in the art, by reading the disclosure of Coghaln, would have known the usefulness of leflunomide compounds for treating viral infection. The detailed mechanism as to how the leflunomide compounds suppressing viral infection is not relevant.

5. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Note McChesney reference was cited to show that Leflunomide is known in the art to provide some benefit for protection animal from viral infection. Considering the cited references as a whole, particularly, the teaching of Coghaln, the claimed invention is obvious as discussed above.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1617

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571)272-0632. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

**SHENGJUN WANG**  
**PRIMARY EXAMINER**



Shengjun Wang

March 16, 2004